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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,052	09/30/2003	Mark Bass	0315-000414/REF	4563

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EXAMINER

FREAY, CHARLES GRANT

ART UNIT	PAPER NUMBER
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3746

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/678,052

Applicant(s)

BASS ET AL.

Examiner

Charles G. Freay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-109 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/2004 and 6/2006.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: the specification at col. 5 line 50 fails to incorporate the changes set forth in the certificate of Correction of September 1, 1998.

Appropriate correction is required.

Claim Objections

Claims 75 and 91-95 are objected to because of the following informalities: the claims fail to incorporate the changes set forth in the certificate of corrections of September 1, 1998. Appropriate correction is required.

Claims 103-109 are objected to as failing to comply with 37 CFR 1.173 ((b) (2)). All amendments in reissue applications must be made relative to the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment (37 CFR 1.173(g)). Therefore, claims 103-109 need to be underlined in their entirety since they are claims presented with or during the prosecution of the reissue application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 24, 30, 31, 57, 89, 96 and 97 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference JP 59-117895 (hereafter JP '895).

JP '895 discloses a scroll type machine having first (24) and second (25) scroll members, a structure (29,131) for supporting the scroll members, a drive member (23) for driving said first scroll to effect relative orbital movement between the scroll members, the scroll members (particularly the second member 25) being moveable axially between a first normal operating relationship (Fig. 2) and a second relationship (Fig. 4) which creates a gap (t) to allow leakage. There is a force applying structure (50), a drive shaft (17) and there is inherently a power source connected to the pulley (20).

With regards to claims 2 and 97 the examiner notes that the term “time pulsed manner” is a broad term and that because no definition of the time periods has been given the JP '895 reference's actuator will inherently operate in a “time pulsed” manner by its normal operation of cycling on and off as the temperature or cooling load changes during operation.

Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP '895.

As set forth above JP '895 discloses the invention substantially as claimed. Furthermore, as noted, in the last lines of page 9 (see the English language translation section) of JP '895 the actuator may be actively controlled. JP '895 states "the temperature of the shape memory alloy (50) can also be changed forcibly using external electric means". Additionally at pages 8-10 JP '895 notes that the actuator can be controlled based upon the temperature of a scroll, the vehicle speed or the cooling load. A sensor and a controller for the actuator are either inherently present for the embodiment where the actuator is forcibly driven by an external electric means or plainly obvious as the examiner gives official notice that a sensor and controller are well known sensing and control mechanisms for providing an external electric control signal which allow for the precise control based upon sensed conditions.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 6, 8-18, 24, 26, 30, 32, 33, 34, 51-53, 66, 68, 84, 85, 89-92, 96 and 103-106 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-24 of copending Application No. 10/184227 in view of Yokoyama (USPN 5,336,058). Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the elements of the claims in the instant invention are present in the claims of the ('227) with the exception of the support structure and the control valve being a solenoid valve or a fluid pressure operated valve. The claims of the instant application and the ('227) application include the same elements but have the elements combined in the claims in different order, resulting in a different scope for the individual claims. When taken together however, claims 16-24 of the ('277) application teach the structure of the instant application minus the teaching of the support structure and the vent valve being either a solenoid valve or a fluid pressure operated valve (claims 14 and 15). Yokohama discloses a similar scroll machine and further discloses a support structure (3) for supporting the scroll elements in their orbital motion. At the time of the invention it would have been obvious to one of ordinary skill in the art to provide a support structure as taught by Yokoyama in order to provide a mechanism for allowing the members to orbit without rotating and to further provide a mechanism for providing secure axial support.

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The examiner gives official notice that solenoid and fluid pressure operated valves are well known control valves which would have been obvious to one of ordinary skill in the art to use as the control valve of the claims in view of their well known and precise control characteristics.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The examiner notes that there was a restriction in U.S. Serial Number 08/486,118 (which resulted in the issuance of US Pat. No. 5,741,120) the original application for this reissue. Further U.S. Serial No. 08/967,851 was filed as a Divisional application of 08/486,118, in response to that restriction requirement, with claims 1-15 being directed to embodiments not included in the prosecution of the 08/486,118 application. Claims 16-24 of 10/184,227 (which is the reissue of the Divisional 08/967,851 application) are directed to subject matter which was elected and prosecuted in the 08/486,118 parent application. While normally the restriction requirement would prohibit a double patenting rejection in these cases, the filing of claims 16-24 in the 10/184227 reissue application has resulted in this prohibition being withdrawn.

Reissue Declaration

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The amendment filed June 23, 2004 added new claims 107 to 109. The declaration of September 30, 2003 does not cover the errors corrected by this amendment.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claim 1-109 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

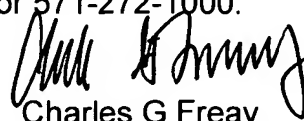
See MPEP § 1414.01.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles G. Freay whose telephone number is 571-272-4827. The examiner can normally be reached on Monday through Friday 8:30 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571-272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Charles G Freay
Primary Examiner
Art Unit 3746

CGF
January 31, 2007